

## REMARKS

This Amendment is accompanied by a Petition for Extension of Time under 37 C.F.R. § 1.136(a) (Form PTO/SB/22) and the requisite large entity fee of \$120 pursuant to 37 C.F.R. § 1.17(a)(1) for a 1-month extension until January 14, 2008.

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### *Amendments to the Specification*

Minor changes have been made to the specification to correct typographical errors.

No new matter has been added.

### *Brief Description of the Present Invention*

10 The present invention discloses methods for managing storage media based upon a two part filtering system using both priority levels and retention rules. The priority levels are based upon certain categories or characteristics of the video data, and are assigned to said data as the data is written to the storage media. The retention rules govern the circumstances in which said data may be overwritten, if necessary, to make room for new data.

15 These priority levels and retention rules come into effect once the media lacks sufficient storage capacity for the new/incoming video data, i.e. when the media is full. When this occurs, the present invention overwrites the existing data pursuant to a two-part process. First all data of the lowest priority level is identified. The retention rules for the lowest priority level are then applied to the identified data to determine if any data of that  
20 priority level may be overwritten. If, after applying the retention rules to all of the identified data, the media still lacks sufficient capacity for the new video data, the invention proceeds, or 'steps up,' to the next priority level. The data of the next priority level are identified, and the retention rules for that priority level are applied to the identified data, all in a manner

similar to that described above. See, for example; page 9, line 7 – page 10, line 4 of the specification (§¶ 0036-0037 of published application).

This ‘step-up’ process continues to successive higher priority levels until sufficient capacity has been identified for the new video data, at which point the identified data is  
5 overwritten by the new data. This process is clarified in the claims by this amendment.

### ***Rejections Under 35 U.S.C. § 102***

The Examiner has rejected claims 1, 10, 11 and 12 as being anticipated under 35 U.S.C. § 102(e) by Klarfeld et al. (US Publ. No. 2003/0067554) In order for an application to be rejected on the basis of anticipation, each essential element of the  
10 claimed invention must appear in a single prior art reference. *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 1571 (Fed. Cir. 1986). The absence of any one claimed element from such reference negates anticipation. *Id.*

#### **Claims 1 and 10:**

The ‘step up’ process disclosed in amended claims 1 and 10 is absent from the  
15 Klarfeld reference. Klarfeld does not organize its programs into separate categories with respect to deletion. Instead, the Klarfeld recording manager requests ratings from the preference agent “of all programs stored,” and deletes the programs “having the lowest rating first.” (See Klarfeld, ¶ 0169.) Klarfeld has no separate rules applicable to any of the programs subject to deletion.<sup>2</sup> Thus, Klarfeld does not provide an automated process for  
20 analyzing programs in different categories, or for ‘stepping up’ from one category to

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<sup>2</sup> Klarfeld provides a method by which its user may manually designate certain programs as non-deletable; however, such designation does not create a new category of programs *subject to deletion*. Instead, such designation merely removes the specified program from the group of deletable files entirely.

another in order to preserve programs in a lower category that are subject to a rule preventing their deletion.

In fact, Klarfeld expressly acknowledges that it suffers from the problem addressed by the 'step up' process claimed herein, in that, under Klarfeld, "[t]he  
5 recordation is subject to storage capacity constraints. For example, if the highest rated program is one-hour long, and only thirty minutes of recording space is available on storage devices 106, then the one-hour program is skilled and the highest rated thirty-minute program is recorded." (See Klarfeld, ¶ 0167.) This acknowledges that the 'step up' process of the present invention is not included in the Klarfeld disclosure, and that, as  
10 such, claims 1 and 10 are not anticipated by Klarfeld.

Claims 11 and 12:

The Examiner has rejected dependent claims 11 and 12 on the basis that they are likewise anticipated by Klarfeld. However, both of these claims depend from claim 10 (claim 12 through claim 11), and are therefore subject to the same limitations disclosed in  
15 claim 10. As discussed above, the 'step up' process disclosed in claim 10 is absent from the Klarfeld reference. Klarfeld therefore does not anticipate claim 10, nor claims 11 and 12 that depend therefrom.

***Rejections Under 35 U.S.C. § 103***

In order to find obviousness based upon a single prior art reference, there must be  
20 some showing of a suggestion or motivation to modify the teachings of that reference to arrive at the claimed invention. *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000).

For combinations of the prior art, there must be some motivation, suggestion or teaching of the desirability of making that specific combination. *Id.*; see also *Alco Standard Corp. v. Tennessee Valley Auth.*, 808 F.2d 1490, 1498, 1 U.S.P.Q.2d 1337, 1343 (Fed. Cir. 1986) (“the question is not simply whether the prior art ‘teaches’ the particular element of the invention, but whether it would ‘suggest the desirability, and thus the obviousness, of making the combination’”); *Creative Pioneer Products Corp. v. K-mart Corp.*, 5 U.S.P.Q.2d 1841, 1844 (S.D. Tex. 1986) (“[t]he mere combination of prior art references does not make an invention obvious unless something in the prior art suggests or reasonably implies an advantage to be derived from uniting their teachings”); *KSR Int’l. v. Teleflex Inc.*, --- U.S. ---, 127 S.Ct. 1727, 1741 (2007) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” [citation omitted].)

Absent such suggestions, the examiner “must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been made obvious in light of the teachings of the references... simplicity and hindsight are not proper criteria for resolving the issue of obviousness.” *Ex Parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Int’f. 1985). *KSR Int’l. v. Teleflex Inc.*, 127 S.Ct. at 1733-34 (2007).

The Examiner has rejected all of the remaining claims on the basis that they are obvious in light of Klarfeld, in view of either Hayashi (US Patent No. 6,434,323) or Kimura (US Patent No. 7,096,237), or both. However, as discussed above, the ‘step up’ process claimed herein is not disclosed in Klarfeld. The Examiner does not cite any

language in Klarfeld that would motivate, suggest or teach this process to a person of ordinary skill in the art. As such, the base reference of Klarfeld does provide a basis for a combination with the remaining references having a 'step up' process, so unless those references provide the necessary suggestion, teaching or motivation, the obviousness rejection is overcome and these claims should be allowed. As set forth below, neither of the other two references (Hayashi and Kimura), either alone or in combination with Klarfeld, or with one another, motivate, suggest or teach the claimed process to a person of ordinary skill in the art, nor do they provide any basis for combining those references with Klarfeld. As such, those references, either alone or in connection with Klarfeld or each other, do not render obvious the claims of the present invention.

More specifically:

Claims 2-9 and 13-15:

The Examiner has rejected claims 2-9 and 13-15 on the basis of Klarfeld and Hayashi. Claims 4 and 14 have been cancelled. The remaining claims depend from amended claims 1 and 10, both of which claim the 'step up' process disclosed herein. Such limitation must therefore be considered when evaluating these claims.

As discussed above, Klarfeld does not render these claims obvious, since it does not disclose, motivate, suggest or teach the 'step up' process. Klarfeld does not disclose, motivate, suggest or teach different priority levels for data *subject to deletion*. (See FN. 1 above.) Instead, Klarfeld discloses that all data subject to deletion (excluding data manually designated by the user as being non-deletable) is placed in a single category, with deletion "of the lowest rating first." (See Klarfeld, ¶ 0169.)

Hayashi likewise does not render these claims obvious. Specifically, it does not disclose, motivate, suggest or teach separate categories of data subject to deletion (the 'step up' process), or different retention rules for separate categories. Instead, as demonstrated in Fig. 8 of Hayashi, such deletion is applied to the entire group of data, subject to the predefined conditions (See col. 10, lines 21-28.); there are no separate categories of data subject to deletion, nor any 'step up' process to traverse the different categories.

Fig. 8 further demonstrates that, unlike the present invention, all data deletion is apparently based upon the same set of erasure conditions. (See col. 10, lines 21-28.) Specifically, Fig. 8 places the record erasure condition (A02) outside the erasure loop (A03-104). Repetition of the erasure loop therefore does not include any revision or re-evaluation of the record erasure condition, i.e. the entire Hayashi deletion process is based upon the same set of erasure conditions.

Since neither Klarfeld nor Hayashi disclose, motivate, suggest or teach separate categories of data subject to deletion (the 'step up' process), or different retention rules for separate categories, the combination of these references cannot provide the necessary motivation, suggestion or teaching of either of these aspects of the present invention either. *See In re Kotzab*, 217 F.3d at 1370; *Alco Standard Corp.*, 808 F.2d at 1498. Accordingly, these references do not render the claims obvious, and the claims should be allowed.

Claims 16-17:

The Examiner has rejected claims 16-17 on the basis of Klarfeld and Kimura. Claim 17 has been cancelled. Amended claim 16 claim comprises the 'step up' process disclosed herein, and must therefore be evaluated with such limitation.

5       As discussed above, Klarfeld is insufficient to render this claim obvious, since it does not disclose, motivate, suggest or teach this 'step up' process.

Kimura likewise does not render this claim obvious. Specifically, Kimura does not disclose, motivate, suggest or teach any means for organizing data into categories for the purposes of deleting said data according to predefined rules, or means for traversing  
10   any different categories of deletion (the 'step up' process). In fact, Kimura is directed toward the recording and reproduction of audiovisual signals onto media, without any emphasis upon the reuse or recycling of such media once their capacities are reached.

Since neither Klarfeld nor Kimura disclose, motivate, suggest or teach different retention rules for separate categories, nor separate categories of data subject to deletion  
15   (the 'step up' process), the combination of these references cannot provide the necessary motivation, suggestion or teaching of these aspects of the present invention either. *See In re Kotzab*, 217 F.3d at 1370; *Alco Standard Corp.*, 808 F.2d at 1498. Accordingly, these references do not render this claim obvious.

Claim 18:

20       The Examiner has rejected claim 18 on the basis of Klarfeld, Hayashi and Kimura. However, this claim depends from independent claim 17, which claims the 'step up' process disclosed herein. Such limitation must therefore be considered when evaluating this claim.

As discussed above, neither Klarfeld, Hayashi nor Kimura alone or in combination, disclose, motivate, suggest or teach different retention rules for separate categories, or separate categories of data subject to deletion (the 'step up' process). As such, these references do not render this claim as obvious.

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### *Conclusion*

In view of the above, it is submitted that all of the remaining claims are in condition for allowance. Allowance of the claims at an early date is solicited.

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10 to 37 C.F.R. § 1.17(a)(1) for a 1-month extension until January 14, 2008. Should any additional fees be required by this paper, the office is authorized to charge any such fees, or credit any overpayments to deposit account 502429.

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Dated: January 14, 2008.

Respectfully Submitted,

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By



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